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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,522	09/22/2003	Andre Stamm	107664.115 US13	5813

26694 7590 01/25/2008

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EXAMINER	
SHEIKH, HUMERA N	

ART UNIT	PAPER NUMBER
1618	

MAIL DATE	DELIVERY MODE
01/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/665,522	STAMM ET AL.	
	Examiner	Art Unit	
	Humera N. Sheikh	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16,18-20 and 36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16,18-20 and 36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 10/665,519.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Application

Receipt of the Request for Continued Examination (RCE) under 37 CFR 1.114, the Amendment and Applicant's Arguments/Remarks, all filed 10/26/07 is acknowledged.

Applicant has overcome the following rejection(s) by virtue of the amendment and/or persuasive remarks: (1) The 35 U.S.C. §103(a) rejection of claims 16, 18-20, 36 and 40 over Curtet *et al.* (USPN 4,895,726) in view of Kerč *et al.* (USPN 6,042,847) has been withdrawn; (2) The 35 U.S.C. 112, first paragraph, new matter rejection of claim 40 has been withdrawn based on cancellation of instant claim 40.

Claims 6, 7, 13, 14, 16, 18-20, 25-33, 36 and 38-40 are pending in this action. Claim 16 has previously been amended. Claims 6, 7, 13, 14, 25-33, 38 and 39 have previously been withdrawn from consideration (based on non-elected invention). Claim 40 has been cancelled herein. Claims 1-5, 8-12, 15, 17, 21-24, 34, 35 and 37 have previously been cancelled. Claims 16, 18-20 and 36 are rejected.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/26/07 has been entered.

* * * * *

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 16, 18-20 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krause (U.S. Pat. No. 4,859,703) in view of Deboeck *et al.* (hereinafter "Deboeck") (U.S. Pat. No. 5, 545,628).

The instant invention is drawn to an orally administrable immediate release fenofibrate tablet, wherein the required daily dosage is lower than 200 mg.

Krause ('703) teaches single dose formulations containing a combination of a lipid regulating agent selected from gemfibrozil, clofibrate, bezafibrate or *fenofibrate* and an ACAT

inhibiting agent that are effective pharmaceutical formulations for regulating blood serum lipid and cholesterol levels (see Abstract); (col. 2, lines 12-22); (col. 4, lines 15-19).

Oral administration forms taught include tablets, as well as capsules, powders and sachets (col. 5, lines 12-20). Powders and tablets contain between about 5 to about 70% by weight of the active ingredient.

The pharmaceutical preparations can be in unit dosage forms (col. 5, lines 36-44).

In therapeutic use, as hypolipidemic or hypcholesterolemic agents, the pharmaceutical compositions are administered to the patient at dosage levels of from 300 to 1200 mg per day of the lipid regulating agent, which can be selected from among others, fenofibrate (col. 5, lines 45-58).

Examples 5-10 at columns 7-9 demonstrate various immediate release tablet formulations comprising a lipid regulating agent selected from gemfibrozil, clofibrate, bezafibrate and fenofibrate. Example 5, for instance presents an immediate release tablet formulation containing 300 mg of lipid regulating agent chosen from gemfibrozil, clofibrate, bezafibrate and fenofibrate. Similarly, Example 6 demonstrates an immediate release tablet formulation containing 450 mg of lipid regulating agent.

Krause teaches that the pharmaceutical compositions are administered at dosage levels of from 300 to 1200 mg per day of the lipid regulating agent, such as for instance, fenofibrate (col. 5, lines 45-58).

Krause does not teach fenofibrate to be provided in a daily dose lower than 200 mg.

Deboeck *et al.* ('628) teach a pharmaceutical composition provided for treating hyperlipidemia or hypercholesterolemia or both, which contains an effective amount of fenofibrate and an excipient (see Abstract); (col. 1, line 6 - col. 2, line 67).

Deboeck teaches that generally, the effective daily amount of fenofibrate for humans ranges from about 100 mg to 600 mg per day, and preferably from about 100 to 300 mg per day (col. 8, lines 18-24); and Claim 12. Also see col. 4, lines 51-63 and col. 7, lines 57-67. This amount/range meets Applicants claimed amount of a daily dose of lower than 200 mg as recited in instant claim 16. These amounts are used to advantageously treat hyperlipidemia or hypercholesterolemia (col. 8, lines 18-20).

Deboeck also teaches that the compositions contain from about 5% to 95% by weight of fenofibrate (col. 3, lines 49-58). Moreover, with regards to amounts and/or ranges, the Examiner points out that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

The pharmaceutical compositions offer increased bioavailability of the fenofibrate as compared to conventional formulations (col. 3, lines 36-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a fenofibrate formulation that comprises a daily effective amount of fenofibrate in amounts lower than 200 mg, such as about 100 mg as taught by Deboeck within the lipid formulations of Krause. One of ordinary skill in the art would be motivated to do so

with a reasonable expectation of success because Deboeck explicitly teaches fenofibrate pharmaceutical compositions whereby the daily effective amount of fenofibrate for humans ranges from about 100 mg to 600 mg per day and Deboeck teaches that these amounts are used in order to advantageously and effectively treat hyperlipidemia or hypercholesterolemia. The expected result would be an improved fenofibrate formulation that has increased bioavailability for the beneficial treatment of hyperlipidemic and high cholesterol conditions.

* * * * *

Claims 16, 18-20 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ghebre-Sellassie *et al.* (hereinafter "Ghebre-Sellassie") (U.S. Pat. No. 4,927,639) in view of Krause (U.S. Pat. No. 4,859,703) and further in view of Deboeck *et al.* (hereinafter "Deboeck") (U.S. Pat. No. 5, 545,628).

The instant invention is drawn to an orally administrable immediate release fenofibrate tablet, wherein the required daily dosage is lower than 200 mg.

Ghebre-Sellassie *et al.* ('639) teach a disintegratable formulation of gemfibrozil providing both immediate and sustained release and comprises a tablet compressed from a mixture of a first and second granulation and a disintegration excipient (see Abstract); (col. 1, lines 9-15; 60-68); (col. 2, lines 63-64).

Ghebre-Sellassie teaches gemfibrozil, a widely used antihyperlipoproteinemic agent (col. 1, lines 9-15).

Ghebre-Sellassie does not teach fenofibrate.

Krause ('703) teaches single dose formulations containing a combination of a lipid regulating agent selected from gemfibrozil, clofibrate, bezafibrate or *fenofibrate* and an ACAT inhibiting agent that are effective pharmaceutical formulations for regulating blood serum lipid and cholesterol levels (see Abstract); (col. 2, lines 12-22); (col. 4, lines 15-19).

Oral administration forms taught include tablets, as well as capsules, powders and sachets (col. 5, lines 12-20). Powders and tablets contain between about 5 to about 70% by weight of the active ingredient.

The pharmaceutical preparations can be in unit dosage forms (col. 5, lines 36-44).

In therapeutic use, as hypolipidemic or hypcholesterolemic agents, the pharmaceutical compositions are administered to the patient at dosage levels of from 300 to 1200 mg per day of the lipid regulating agent, which can be selected from among others, fenofibrate (col. 5, lines 45-58).

Examples 5-10 at columns 7-9 demonstrate various immediate release tablet formulations comprising a lipid regulating agent selected from gemfibrozil, clofibrate, bezafibrate and fenofibrate. Example 5, for instance presents an immediate release tablet formulation containing 300 mg of lipid regulating agent chosen from gemfibrozil, clofibrate, bezafibrate and fenofibrate. Similarly, Example 6 demonstrates an immediate release tablet formulation containing 450 mg of lipid regulating agent.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate any lipid regulating agent, particularly fenofibrate, as taught by Krause within the lipid composition of Ghebre-Sellassie. One of ordinary skill in the art would be motivated to do so with a reasonable expectation of success because Krause explicitly teaches single dose formulations containing a combination of a lipid regulating agent that can be selected from gemfibrozil, clofibrate, bezafibrate or *fenofibrate* and teach that such lipidemic agents are effective for regulating blood serum lipid and cholesterol levels. The expected result would be an enhanced fenofibrate composition that exhibits increased bioavailability and effective treatment of hyperlipidemia and hypercholesterolemia.

The teachings of Ghebre-Sellassie and Krause are delineated above. They do not teach fenofibrate to be provided in a daily dose lower than 200 mg.

Deboeck *et al.* ('628) teach a pharmaceutical composition provided for treating hyperlipidemia or hypercholesterolemia or both, which contains an effective amount of fenofibrate and an excipient (see Abstract); (col. 1, line 6 - col. 2, line 67).

Deboeck teaches that generally, the effective daily amount of fenofibrate for humans ranges from about 100 mg to 600 mg per day, and preferably from about 100 to 300 mg per day (col. 8, lines 18-24); and Claim 12. Also see col. 4, lines 51-63 and col. 7, lines 57-67. This amount/range meets Applicants claimed amount of a daily dose of lower than 200 mg as recited in instant claim 16. These amounts are used to advantageously treat hyperlipidemia or hypercholesterolemia (col. 8, lines 18-20).

Deboeck also teaches that the compositions contain from about 5% to 95% by weight of fenofibrate (col. 3, lines 49-58). Moreover, with regards to amounts and/or ranges, the Examiner points out that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

The pharmaceutical compositions offer increased bioavailability of the fenofibrate as compared to conventional formulations (col. 3, lines 36-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a fenofibrate formulation that comprises a daily effective amount of fenofibrate in amounts lower than 200 mg, such as about 100 mg as taught by Deboeck within the lipid formulations of Ghebre-Sellassie and alternatively, Krause. One of ordinary skill in the art would be motivated to do so with a reasonable expectation of success because Deboeck explicitly teaches fenofibrate pharmaceutical compositions whereby the daily effective amount of fenofibrate for humans ranges from about 100 mg to 600 mg per day and Deboeck teaches that these amounts are used in order to advantageously and effectively treat hyperlipidemia or hypercholesterolemia. The expected result would be an improved fenofibrate formulation that has increased bioavailability for the beneficial treatment of hyperlipidemic and high cholesterol diseases.

* * * * *

Response to Arguments

Applicant's arguments, see Response pages 3-6, filed 10/26/07, with respect to the rejection(s) of claim(s) 16, 18-20, 36 and 40 under 35 U.S.C. §103(a) and the rejection of claim 40 under 35 U.S.C. 112, first paragraph rejection have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the Krause (USPN 4,859,703); Ghebre-Sellasie et al. (USPN 4,927,639) and Deboeck *et al.* (USPN 5,545,628) prior art references.

Conclusion

--No claims are allowed at this time.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday during regular business hours. (Wednesdays - Telework).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley, can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Humera N. Sheikh

HUMERA N SHEIKH
PRIMARY EXAMINER

Art Unit 1615

January 22, 2008

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